REMARKS

Applicants appreciate the detailed examination evidenced by the second Office Action. Applicants also appreciate the Examiner's withdrawal of all of the earlier rejections in view of Applicants' earlier Amendment. Independent Claims 1, 27, 31, and 32 have now been amended to more clearly define the patentable distinctions over the newly cited U.S. Patent No. 5,826,025 to Gramlich ("Gramlich"). No new matter has been introduced by these amendments. Claims 2, 3, 28, and 30 have been canceled. Applicants respectfully submit that all the pending claims are patentable for the reasons that now will be described.

Amended Claims 1, 27, 31, and 32 Are Statutory Under 35 USC § 101

Claims 1 and 27 have been amended to recite a "computer-implemented method" and Claim 31 has been amended to recite a "computer system" which Applicants submit are directed to statutory subject matter under 35 USC § 101.

Applicants submit that the recitation of Claim 32 that the computer program product is "embodied on one or more computer-readable media" also satisfies 35 USC § 101. Applicants submit that the Office Action erroneously characterizes the computer memory embodiment of media as an "intangible embodiment" that is not statutory subject matter. Applicants submit that a computer memory is a physical media, and that the computer program product on a computer memory media is statutory subject matter under 35 USC § 101.

Independent Claims 1, 27, 31, and 32 are Patentable Over Gramlich

Claims 1-5, 27-28, and 30-32 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,826,025 to Gramlich ("Gramlich"). Independent Claims 1, 27, 31, and 32 have been amended to clarify the patentable difference between the claimed transcoding and the document merging described by Gramlich. Applicants submit that the amended independent claims are patentable over Gramlich for at least the reasons that will now be explained.

Amended Claim 1 recites:

1. (Currently amended)   A computer-implemented method of document transcoding, comprising:

specifying one or more annotations coded according to a first syntax of one of Hypertext Markup Language (HTML), Extensible Markup Language (XML), Wireless Markup Language (WML), and Handheld Device Markup Language (HDML), wherein the one or more annotations indicate one or more conditions for when they are to be inserted into a document; and

selectively inserting the specified annotations in a target document coded according to a second syntax of a different one of HTML, XML, WML, and HDML from the first syntax based on whether the indicated one or more conditions are satisfied, thereby transcoding the target document.

Remaining independent Claims 27, 31, and 32 are method, computer system, and computer program product analogs of independent Claim 1. They have been amended similarly and will not be analyzed separately.

These amendments have been made to clarify the document transcoding that is carried out by embodiments of the invention. These embodiments recite that annotations are coded according to a first syntax of one of Hypertext Markup Language (HTML), Extensible Markup Language (XML), Wireless Markup Language (WML), and Handheld Device Markup Language (HDML). The annotations indicate one or more conditions for when they are to be inserted into a document. The specified annotations are selectively inserted into a target document that is coded according to a second syntax of a different one of HTML, XML, WML, and HDML from the first syntax based on whether the indicated conditions are satisfied, which transcodes the target document.

In sharp contrast, Gramlich discloses, with reference to FIG. 1 below, a system in which a Web browser 112 requests an HTML document from a web server 142. An annotation overlay proxy (AOP) 114a merges selected annotations 119a-f from an annotation directory 118 into the HTML document from the web server 142 to generate a merged HTML document 120 that is provided to the Web browser 112. (See for example Gramlich, Col. 3, line 61- Col. 5, line 50). See also Gramlich Col 6, lines 16-23 which recites:

> The AOP 114 then creates the merged document 120 by transforming the returned image 115 of the requested document 146 according to the information from the annotations 119a,b,e,f. This transformation is effected by the AOP 114 adding HTML-formatted content to the merged document 120 so that the annotations are

seamlessly integrated with the requested document and viewable using existing Web browsers such as the browser 112.

According to Gramlich, the annotations 119a-f in the annotations directory, the document retrieved from the web server 142, and the merged document are all coded with the same HTML syntax.

FIG. 1 OF GRAMLICH
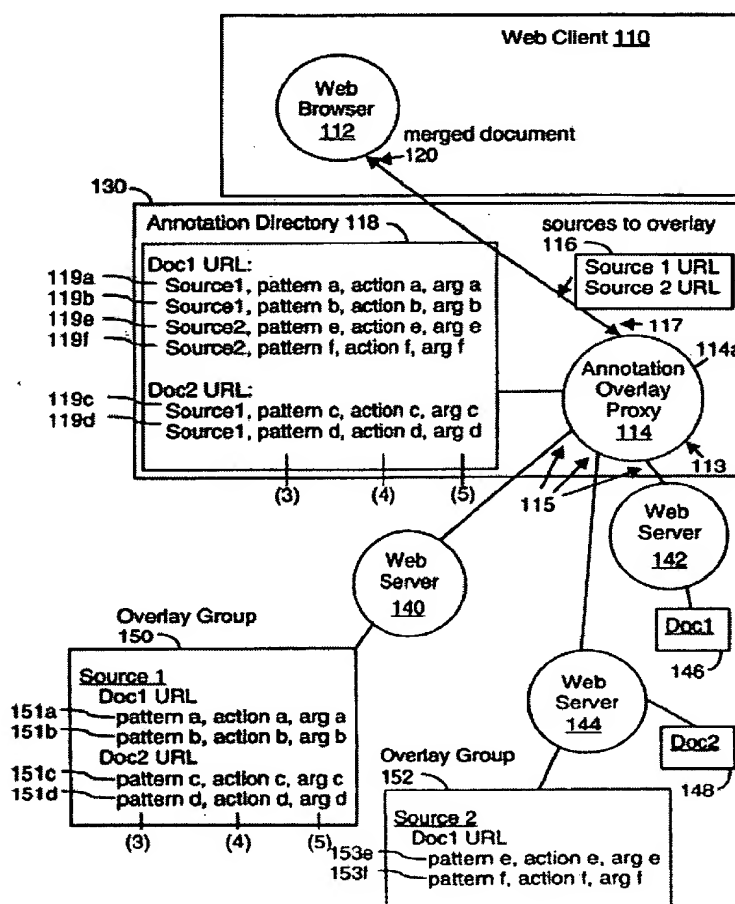
Gramlich does not teach or suggest transcoding a document by specifying annotations that are coded according to a first syntax of either HTML, XML, WML, or HDML, and selectively inserting the annotations into a document that is coded according to a second syntax of a different one of HTML, XML, WML, and HDML from the first syntax based on

whether the indicated conditions are satisfied. For at least these reasons, Applicants submit that Claims 1, 27, 31, and 32 are patentable over Gramlich.
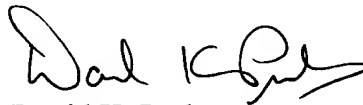
The dependent claims are patentable at least per the patentability of the independent claims from which they depend. In view of this clear patentability, the dependent claims will not be analyzed separately.

Conclusion

Applicants again appreciate the Examiner's thorough analysis and citation to Gramlich, and the withdrawal of all of the earlier rejections from the Office Action of August 23, 2004. Applicants have now shown that Applicants' document transcoding is patentable over Gramlich's document merging.

Accordingly, all of the pending claims are now in condition for allowance, which is respectfully requested.

Respectfully submitted,

David K. Purks
Registration No. 40,133
Attorney for Applicant(s)

USPTO Customer No. 46589
Myers Bigel Sibley & Sajovec, P.A.
Post Office Box 37428
Raleigh, NC 27627
Telephone: (919) 854-1400
Facsimile: (919) 854-1401